

REMARKS

Claims 19 to 26 are added, and therefore claims 9 to 11, 13 to 17 and 19 to 26 are pending.

Reconsideration is respectfully requested based on the following.

With respect to paragraph three (3) of the Office Action, as to the “antecedent basis” objection as to claim 9, while the objection may not be agreed with, to facilitate matters, claim 9 has been rewritten without prejudice rendering the objection moot. It is therefore respectfully requested that the objection be withdrawn.

As to paragraph four (4), claims 9-11 and 13-17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

While the rejections may not be agreed with, to facilitate matters, claim 9 has been rewritten. It is therefore respectfully requested that the indefiniteness rejection be withdrawn.

As to paragraph five (5), claims 9 to 11, 13, 14, and 17 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,309,132 (“Jakob”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 9 has been rewritten. Claim 9, as presented, is to “a self-locking bolt . . . having engagement surfaces for a tool at an end of the shank, wherein the head has a bottom surface connecting the head to the shank and a top surface that is round and smooth.” The Office Action asserts that “Jakob” Fig. 1 (24, 36) shows a head, and that “the top of 38 is perpendicular to the axis of the shank and is round and smooth.” *As detailed in the response to the first Office Action -- and never addressed by the Office, the “top” surface of Jakob cannot be described as having a smooth surface because it has a hexagon shaped tool interface protruding out of it.*

From the online dictionary selected by the Office, the word “smooth” has a first definition of “free from projections or unevenness of surface; not rough.” (<http://wordnet.princeton.edu/perl/webwn?s=smooth>). The surface of the head, which is not attached to the shank, is clearly not “free from projections,” as the tool interface is projecting from it. Thus, neither surface of “Jakob” is a “smooth surface.” Accordingly, “Jakob” does not identically disclose (nor even suggest) all of the features of claim 9, as presented, so that it is allowable.

Claims 10, 11, 13, 14 and 17 depend from claim 9, as presented, and are therefore allowable for at least the same reasons.

As regards paragraph eight (8), claims 15 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Jakob” in view of EP 0747604.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Id., at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 15 and 16 depend from claim 9, as presented, and are therefore allowable for the same reasons, since any review of the secondary reference makes plain that it does not cure -- and it not asserted to cure -- the critical deficiencies of the primary reference.

New claims 19 to 26 do not add any new matter and are supported by the present application. Claims 19 to 26 depend from claim 9, as presented, and are therefore allowable for the same reasons.

Accordingly, claims 9 to 11, 13 to 17 and 19 to 26 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of claims 9 to 11, 13 to 17 and 19 to 26 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

Dated: 10/17/2008

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